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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,027	10/31/2003	Kazuo Okada	SHO-0043	1099

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RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER
HSU, RYAN

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,027	OKADA, KAZUO	
	Examiner	Art Unit	
	RYAN HSU	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 11-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 11-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the Request for Continued Examination (RCE) under 37 CFR 1.114 filed on 7/22/09. Claims 1-2 have been amended and 3-10 have been canceled without prejudice. Additionally, claims 11-19 have been newly added. Claims 1-2 and 11-19 are pending in the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-7 of copending Application No. 10/697,238. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards a gaming machine that comprises a variable display device that displays designs or symbols. Additionally, they include a front electric display which consist from a group of at least a liquid crystal display panel or series of light emitting diodes. This display

uses a light guiding plate to create an illuminating effect for the display device so that a gaming machine can produce several different arrays of symbols and designs that compliment the basic reel display device commonly found in game machines. The two sets of claims have simply been rearranged so that they are claimed in different orders and are directed towards the same device except one uses a light emitting diode and the other a liquid crystal display. However, these are different forms of lighting display devices and perform the same function therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either type of lighting device to perform the same functions as described in the claims. Therefore it would be obvious that these two inventions are not patentably distinct but simply have used alternative synonyms and language structure to detail the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miur et al. (US 2005/0192090 A1) and further in view of Uchiyama et al. (US 6,638,165 A)

Regarding claims 1 and 15, Miur et al. teaches a gaming machine comprising: a variable display device for variably displaying symbols (*see [0006-0012]*). Additionally, Muir discloses a front display device disposed in front of the variable display device wherein the front display device includes a transparent liquid crystal display panel through which the variable display device is able to be seen. This is shown through Muir's incorporation of light transmitting symbol which can appear through the transparent LCD (light crystal display panel) device or may display symbols in place of the symbols on the variable display device (*see Figs. 6-7 and the related description thereof, [paragraph [0011, 0018, 0022-0029], [0051-0053]*). Additionally, Muir teaches the display device to incorporate a light guiding plate between the reel and the liquid crystal panel, the light guiding plate for guiding light emitted from a light source to the liquid crystal panel, the light guiding plate provided with an opening serving as a display window corresponding to the reel, the opening formed in a transparent area for ensuring visibility of the symbols on the reel, the opening through which the reel is able to be displayed so that the symbols drawn on the reel are transparently displayed on the liquid crystal panel. Finally, Muir teaches a transparent liquid crystal display panel, the diffusion sheet and the light guiding plate to be arranged in a facially-opposed sequential manner such that the diffusion sheet [76] is disposed between the transparent LCD panel [50] and the light guiding plate [64,66] and the light guiding plate[64, 66] is disposed between the diffusion sheet [76] and the variable display device [18] (*see Fig. 8 and the related description thereof*).

In an analogous gaming patent, Uchiyama teaches another example of a gaming machine that comprises two displays that are placed one in front of the other. Uchiyama

teaches that one display is a mechanical or physical reel system while the other is video display device (*see Fig. 8(a-c) and the related description thereof*). Uchiyama teaches in addition to the features of Muir a video display device is capable of displaying light transmitting symbols that can variably move about the screen (*see col. 12: ln 21-col. 13: ln 40*). One would be motivated to incorporate the features of Uchiyama with that of Miur in order to create a more stimulating visual experience for the user. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Muir with that of Uchiyama as it would not change the physical capabilities of Muir invention but would add an element that is known in the arts as creating a more visually stimulating experience.

Regarding claims 2, 11 and 16, Muir teaches a gaming machine that is a slot machine and a variable display device that is one or more rotatable reels each having a reel band thereon on which the symbols are drawn and the reel of the variable display device is disposed internally of the gaming machine so that part of an outer periphery of the reel, the part positioned at the forefront is exposed from the opening of the light guiding plate (*see element [16,18] of Fig. 8 and the related description thereof*).

Regarding claims 12-14, 17-19, Muir teaches a gaming machine where the diffusion sheet disposed between the transparent liquid crystal display panel and the light guiding plate, the diffusion sheet disposed between the transparent liquid crystal display panel and the light guiding plate, the diffusion sheet for diffusing the light toward the transparent liquid crystal display panel, the light having been guided by the light guiding plate, the diffusion sheet provided with an opening corresponding to the opening of the light guiding plate so that the symbols on the variable display device are displayed on the

transparent liquid crystal display panel through the opening of the light guiding plate (*see Fig. 8 and the related description thereof*). Additionally, Muir teaches a gaming machine that includes a reflection plate disposed between the light guiding plate and the variable display device, the reflection plate for reflecting the light on the transparent liquid crystal display panel, the light having been emitted from the light source to the light guiding plate, the light having been emitted from the light source to the light guiding plate, the reflection plate provided with an opening corresponding to the opening of the light guiding plate so that the symbols on the variable display device are displayed on the transparent liquid crystal display panel through the opening of the light guiding plate (*see element [78, 64, 60, and 80] of Fig. 8 and the related description thereof*). Furthermore, Muir teaches a variable display unit that contains all the limitations of the instant claims however they are not necessarily in the direct order in which the current limitations have specified. However, having a light source layer on before or after the light guiding plate would not affect the overall output and novel appearance created by such a design. Therefore it would have been an obvious matter of design choice to one of routine skill in the art to select where the light source layer would occur. Additionally, the instant claims are directed towards attributes that are inherent with a light guiding plate. When a solid object is placed in front of a lighted area, only the places where an opening exists will light be projected out of the source. Thus it would have been obvious to one of ordinary skill in the art to produce the expected result that using a light guiding plate would allow for the light to reveal the reels would be projected to provide the user the ability to see the reels of a gaming machine.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The amended and new claims are directed towards subject matter that was different than what was previously considered and has been addressed in the rejection above.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached at (571)-272-4437.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

/John M Hotaling II/

Supervisory Patent Examiner, Art Unit 3714

RH

August 16, 2009